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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/337,243 | 06/22/1999 | SCOTT D. MAURER | 117077-4 | 8744 |

21324 7590 02/24/2004
HAHN LOESER & PARKS, LLP
TWIN OAKS ESTATE
1225 W. MARKET STREET
AKRON, OH 44313

EXAMINER

SAFAVI, MICHAEL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3673

DATE MAILED: 02/24/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/337,243

Applicant(s)

MAURER, SCOTT D.

Examiner

M. Safavi

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-92 and 94-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 85-87, 90-92 and 94 is/are allowed.
- 6) ☒ Claim(s) 88, 89 and 95-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2003 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 88 and 89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 88 appears to define the claimed molding as packaged in a roll when claim 85, from which claim 88 depends, defines the claimed molding as applied to a wall and ceiling along the intersection of the wall and ceiling. It is therefore, not understood as to how the molding of claim 85 can be "packaged in a roll".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 3673

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 95 and 96 are rejected under 35 U.S.C. 102(b) as being anticipated by
Stewart et al.

Stewart et al. discloses, Figs. 6 and 7, a closed cell plastic foam member 11, col. 3, lines 15-17, with pressure sensitive adhesive applied along each edge thereof, col. 4, lines 67-68 and col. 5, lines 9-13. The edges of member 11 can be seen as forming first and second flat surface profiles carrying the adhesive while extending in a spaced apart substantially orthogonal relationship to one another. A front surface profile can be seen as substantially matching a rear surface profile. The central portion of member 11 can be seen as extending at an angle between the first and second orthogonal flat surface profiles.

Claims 95 and 97 are rejected under 35 U.S.C. 102(a) as being anticipated by
Lane et al.

Lane et al. discloses, Fig. 2, a plastic foam member 12, col. 3, lines 14-15, with pressure sensitive adhesive applied along each edge thereof, col. 4, lines 28-29 The edges of member 11 can be seen as forming first and second flat surface profiles carrying the adhesive while extending in a spaced apart substantially orthogonal

Art Unit: 3673

relationship to one another. The member 12 is attached to an intersection of a wall and ceiling 36, 38.

Claim 95 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson.

Johnson discloses, Figs. 2 and 3, a plastic foam member 12 or 12/16/17 with pressure sensitive adhesive 18 or 19 applied along each edge thereof. The edges of member 12 or 12/16/17 can be seen as forming first and second flat surface profiles carrying the adhesive while extending in a spaced apart substantially orthogonal relationship to one another. A front surface profile can be seen as substantially matching a rear surface profile. The central portion 15 of member 12 or 12/16/17 can be seen as extending at an angle between the first and second orthogonal flat surface profiles.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 96 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

To have formed the Johnson member 12 or 12/16/17 of a closed cell foam, thus providing the desired durable quality of the molding, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made.

Claims 95 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckel et al. in view of Johnson.

Eckel et al. discloses, Fig. 2, a monolithic plastic molding having front side and rear side with a first layer of pressure sensitive adhesive along a first flat surface profile of the rear side and a second layer of pressure sensitive adhesive along a second flat surface profile of the rear side. A central portion, (e.g., 4), of the molding extends between the first flat surface profile and the second flat surface profile at an angle between. The first flat surface profile can be seen as oriented about perpendicular to the second flat surface profile. A front surface profile can be seen as substantially matching a rear surface profile.

Johnson discloses a molding 12 or 12/16/17 formed of a foam material with the molding possessing adhesive strips 19 along edges of a rear side thereof. Release material for the adhesive strips is shown at 20.

To have formed the Eckel et al. molding of a foam, in particular a closed cell foam, including a polyethylene foam, thus providing a light weight molding with sufficient cushioning properties, would have constituted an obvious expedient to one having ordinary skill in the art as taught by Johnson.

Claims 85-87, 90-92, and 94 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2481. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
February 23, 2003